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Name of applicant, assignee or registered representative

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October 3, 2006
Date of Signature

PATENT
Case No. GP-301610
(2760/26)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:)	
)	
WILLIAM E. MAZZARA, JR., ET AL.)	Examiner: CAI, WAYNE H.
)	
Serial No.: 10/040,049)	
)	Group Art Unit: 2681
Filed: NOVEMBER 7, 2001)	
)	
For: METHOD FOR PROVIDING)	Conf. No.: 1827
MULTI-PATH COMMUNICATION)	
FOR A MOBILE VEHICLE)	

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Dear Sir:

Please consider Appellant's reply brief as follows.

The §112 rejections

Appellants thank the Examiner for the withdrawal of the §112 rejections, and are pleased that the issues before the Board have been narrowed to the anticipation and obviousness rejections.

The §102(e) rejections

Claims 25, 34, 37 and 46 were rejected as anticipated by Yamashita. This rejection is traversed.

The Examiner continues to confuse the claimed invention and disclosures of Yamashita. The Examiner has asserted an anticipation rejection, even though Yamashita does not disclose each claimed element. A claim is anticipated *only* if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention *must be shown in as complete detail* as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102(e) rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. Appellants respectfully assert that the cited reference fails to do so.

Yamashita does not disclose “initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination”. At most, Yamashita discloses determining whether to connect to a network using a first or second radio communication section (radio communication sections 1, 2) based on a determination of whether the vehicle is in “high speed transit”. See ¶ 34, Yamashita.

The Examiner's argument (p. 8 of the Answer) that Yamashita discloses the claim element in ¶52 is misplaced. Whether Yamashita discloses determining if both radio communication sections are available, or not, is not relevant to an anticipation rejection. The Examiner essentially acknowledges this by stating "[T]herefore, this step taught by Yamashita reads on the step of determining availability of at least one embedded device, and at least one portable network access device of the claimed limitation." Again, the veracity of the Examiner's statement is *irrelevant*, because the claim *actually requires* something entirely different – the claim *actually requires* "initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination".

As for the Examiner's arguments on what Yamashita teaches or suggests (see p. 9 of the Answer), Appellants gently remind the Examiner of the standards for anticipation rejection as outlined above. What Yamashita teaches or does not teach is not germane to a rejection under §102(e). Thus, while Appellants entirely disagree with the Examiner's statements about Yamashita's teachings as applied in the §102(e) rejection, even if true, such statements do not allege a prima facie case of anticipation.

Yamashita discloses two devices for "connecting to a network": radio communication section 1 is "a communication system not warranting communication capability when in fast transit, preferably means of communication which makes possible connection to a cordless system such as PHS" and radio communication section 2 is "a communication system warranting communication when in fast transit, preferably means of communication such as a portable telephone." See ¶29, Yamashita.

In view of these two communication systems, Yamashita notes that if the bearer, while riding a vehicle, stands by or initiates a call via the cordless system, the conversation may be interrupted when the vehicle accelerates beyond a certain speed. See ¶7, Yamashita. In view of this possibility, Yamashita attempts to provide an apparatus for mobile communications capable of automatically accessing the most "*suitable* system for intended communication" (¶9, emphasis added), and a system capable of automatically forbidding access to any communication system

“*unsuitable*” (§10, emphasis added), for communication during high speed transit. Additionally, Yamashita discloses that the apparatus includes a control section to judge whether communication during high speed transit is possible, and if possible, forbids a radio communication section communicating with a system “*inappropriate*” for communication during high speed transit from standing by or initiating a call. See §11 (emphasis added), Yamashita. Thus, the determination is not based on *capability*, but rather suitability or appropriateness.

In distinct contrast, claims 25, 37, and 46 require initiating a connection to the network using one of the at least one embedded device or at least one portable network access device based on the capability determination. Claims 25, 37, and 46 do not claim initiating the connection based on the speed of the vehicle (i.e. in high speed transit), but rather based on the determined capability.

Claim 34 depends directly from claim 25, and is therefore not anticipated by Yamashita for at least the same reasons.

Withdrawal of the rejections to claims 25, 34, 37, and 46 is requested.

The §103(a) rejections over Yamashita

The §103(a) rejections of claims 26, 33, 35, 38, and 45 as unpatentable over Yamashita are traversed.

Claims 26, 33 and 35 depend directly from claim 25, and are therefore not unpatentable over Yamashita for at least the same reasons as claim 25. Claims 38 and 45 depend directly from claim 37, and are therefore not unpatentable over Yamashita for at least the same reasons as claim 37.

The §103(a) rejections over Yamashita in view of Khullar

The §103(a) rejections of claims 27-32 and 39-44 as unpatentable over Yamashita in view of Khullar are traversed. Claims 27-32 depend directly from claim 25, and are therefore not unpatentable over Yamashita in view of Khullar for at least the same reasons as claim 25. Claims 39-44 depend directly from claim 37, and are therefore not unpatentable over Yamashita in view of Khullar for at least the same reasons as claim 37.

Additionally, there is no motivation to combine Yamashita with Khullar. The mere fact that Yamashita can be modified in view of Khullar to obtain the claimed invention (which Appellants deny) does not render the resultant modification obvious unless the prior art also suggests the desirability of the combination. See, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner's cited motivation, "to determine the ability to make a connection or service, and make the communication more reliable and efficient" fails to note exactly where either reference makes such a suggestion. The mere fact that references can be modified is not support for an obviousness rejection. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The §103(a) rejections over Yamashita in view of Holmstrom

The §103(a) rejections of claim 36 as unpatentable over Yamashita in view of Holmstrom is traversed. Claim 36 depends directly from claim 25, and are therefore not unpatentable over Yamashita in view of Holmstrom for at least the same reasons as claim 25.

Withdrawal of the rejections to claims 26-33, 35-36, and 38-45 is requested.

SUMMARY

The Appellant respectfully submits that claims 1-22 herein fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing, favorable consideration and passage to issue of the present application is respectfully requested. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Dated: **October 3, 2006**

Respectfully submitted,
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